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| 09/820,803  | 03/30/2001  | Ravi Ganesan         | 23952-0147                | 5542             |
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| SUTHERLAND II<br>SUTHERLAND, ASBILL & BRENNAN, LLC<br>999 PEACHTREE STREET<br>ATLANTA, GA 30309 |             |                      | EXAMINER<br>COLBERT, ELLA |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/820,803

**Applicant(s)**

GANESAN ET AL.

**Examiner**

Ella Colbert

**Art Unit**

3696

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 12-15, 24, 25, 35-38, 56, 59-66 and 69-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 12-15, 25, 35-38, 56, 59-66 and 69-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1, 2, 12-15, 24, 25, 35-38, 56, 59-66, and 69-76 are pending. Claims 1, 2, 12-15, 24, 35, 56, 59-66, 70-72, and 74-76 have been amended in this communication filed 07/28/09 entered as Response After Non-Final Action.
2. The Interview Summary was entered 08/07/09.
3. The objections for claims 2, 12-14, 25, 35-37, 56, 59, 60, and 62-65 from the Office Action of 4/28/09 have been overcome by Applicants' amendments to the claims and are hereby withdrawn.
4. The 35 USC 112, Second Paragraph Rejection from the Office Action of 4/28/09 is hereby withdrawn in part as set forth here below.
5. The drawing objections have been overcome by Applicants' submission of formal drawings on 7/28/09 has been overcome and are hereby withdrawn. The drawings have been reviewed and entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 24, 56, 61, 66, 71, and 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "the processing agent". It is unclear from reading the specification and viewing the drawings whether the "processing agent is a person or a device or a piece of software.

Claim 1 also recites "... , a closed payment screen that only allows payment to any of the defined plurality of preferred payees; and transmitting, from the processing agent when the registration status is set to the open status, an open payment that allows payment to either any of the defined plurality ...". These claim limitations are vague and indefinite because it cannot be determined how the plurality of preferred payees are defined. Are they defined by their registration status to closed status or open status? Also, the recitation "allows payment to either any of the defined plurality of preferred payees or to one of the other payees" is vague and unclear. Do Applicants' mean "in which payment can be made to any of the defined plurality of preferred payees or to at least one of the payees? Claims 24 and 56 have similar issues. Also, the dependent claims 62, 72, and 75 have a similar issue with the terms "the other".

Claim 1, the third claim limitation is written as such that the metes and bounds of the claim limitation cannot be determined. Claims 24 and 56 have a similar issue.

Claims 24, 56, 61, 66, 71, and 76 have a similar problem. Claims 2, 12-15, 25, 35-38, and 57-76 are also rejected for their dependency from a rejected claim.

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 24, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,289,322) Kitchen et al, hereafter Kitchen in view of "Yahoo! Presents Yahoo! E-Bills; Yahoo! Expands Relationship with CheckFree to Provide Millions of Users Ability to Receive and View Bills Online" (NPL reference), hereafter "Yahoo!E-Bills".

Claims 1, 24, and 56. Kitchen discloses, A method comprising: receiving by a processing agent, information identifying a network user (col. 6, line 59-col. 7, line 5 and col. 11, lines 41-56); determining by the processing agent responsive to receiving the information identifying the network user, a credit risk associated with making, payments on behalf of the network user (col. 12, lines 35-47). Kitchen failed to disclose, setting by the processing agent based at least in part on the determined credit risk, a registration status for the network user to one of (i) a closed status indicating that the processing agent will only process payment requests on behalf of the network user to preferred payees included in a defined plurality of preferred payees, or (ii) an open status indicating that the processing agent will process payment requests on behalf of the network user to either the preferred payees or to other payees not included in the defined plurality of preferred payees; transmitting, from the processing agent, when the registration status is set to the closed status, a closed payment screen that only allows payment to any of the defined plurality of preferred payees and transmitting, from the processing agent when the registration status is set to the open status, an open payment screen that allows payment to either any of the defined plurality of preferred

payees or to one of the other payees. "Yahoo! E-Bills" discloses, setting by the processing agent based at least in part on the determined credit risk, a registration status for the network user to one of (i) a closed status indicating that the processing agent will only process payment requests on behalf of the network user to preferred payees included in a defined plurality of preferred payees, or (ii) an open status indicating that the processing agent will process payment requests on behalf of the network user to either the preferred payees or to other payees not included in the defined plurality of preferred payees (pg. 2, para.'s 3-pg. 3, para. 1); transmitting, from the processing agent, when the registration status is set to the closed status, a closed payment screen that only allows payment to any of the defined plurality of preferred payees (pg. 1, para. 4-pg. 2, para. 3); transmitting, from the processing agent when the registration status is set to the open status, an open payment screen that allows payment to either any of the defined plurality of preferred payees or to one of the other payees, wherein the prior steps are performed by one or more server computers associated with the processing agent (pg. 2, para.'s 3 and 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kitchen with the teachings of "Yahoo! E-Bills" because such a modification would allow Kitchen to reduce the operating and administrative costs for accounting and disbursement activities.

Claim 24, Kitchen further discloses, a communications port configured to receive and transmit information via a network (col. 6, lines 20-28); a memory (col. 6, lines 29-58); and a processor in communication with the communications port and the memory (col.

7, lines 37-51). This independent claim is rejected for the similar rationale as given above for claim 1.

Claim 56 is rejected for the similar rationale as above for independent claims 1 and 24.

Claims 2, 12-15, and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,289,322) Kitchen et al, hereafter Kitchen and "Yahoo! Presents Yahoo! E-Bills; Yahoo! Expands Relationship with CheckFree to Provide Millions of Users Ability to Receive and View Bills Online" (NPL reference), hereafter "Yahoo! E-Bills" in view of (US 7,194,437) Britto et al, hereafter Britto.

Claims 2 and 25. Kitchen discloses, wherein receiving information identifying a network user comprises receiving information identifying the network user from a sponsor of the network user (col. 12, lines 49-65).

Claims 12 and 35. Kitchen failed to disclose, wherein setting the registration status comprises setting the registration status when the defined plurality of preferred payees is determined by a first entity other than the network user. Britto discloses, wherein setting the registration status comprises setting the registration status when the defined plurality of preferred payees is determined by a first entity other than the network user (col. 6, lines 13-67).

Claims 13 and 36. Kitchen failed to disclose, wherein setting the registration status comprises setting the registration status when the entity is a sponsor of the network user. Britto discloses, wherein setting the registration status comprises setting the

registration status when the entity is a sponsor of the network user (col. 6, lines 3-12).

Claims 14 and 37. Kitchen failed to disclose, wherein setting the registration status comprises setting the registration status when the entity is the processing agent. Britto discloses, wherein setting the registration status comprises setting the registration status when the entity is the processing agent (col. 5, lines 55-65).

Claims 15 and 38. Kitchen discloses, wherein setting the registration status associated with the network user to one of the open status or the closed status comprises setting the registration status based at least in part upon the identity of the a sponsor of the network user (col. 13, lines 48-62).

Claims 59-66, 69-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,2898,322) Kitchen et al, hereafter Kitchen and "Yahoo! Presents Yahoo! E-Bills; Yahoo! Expands Relationship with CheckFree to Provide Millions of Users Ability to Receive and View Bills Online" (NPL reference), hereafter "Yahoo! E-Bills" in view of (US 7,194,437) Britto et al, hereafter Britto and further in view of (US 6,311,170) Embrey.

Claims 59, 62, 69, and 72. Kitchen, "Yahoo! E-Bills" and Britto failed to disclose, further comprising: setting the registration status to the closed status prior to determining the credit risk and during a real-time communication session with the network user, wherein the registration status is set to the open status outside a real-time communication session with the network user. Embrey discloses, wherein executing



computer-implemented instructions performed by one or more processing agent processors further comprises executing computer-implemented instructions performed by one or more processing agent processors for: setting the registration status to the closed status prior to determining the credit risk and during a real-time communication session with the network user, wherein the registration status is set to the open status outside a real-time communication session with the network user (col. 15, lines 4-17 and col. 15, line 18-col. 16, line 42). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kitchen with the teachings of Embrey because such a modification would allow Kitchen to have the security of a payment system by minimizing the opportunity for alteration of any negotiable instruments.

Claims 60 and 70. Kitchen, "Yahoo! E-Bills", Britto and Embrey failed to disclose, wherein determining the credit risk further comprising: determining, subsequent to setting the registration status, a second credit risk associated with making payments on behalf of the network user; wherein changing the registration status to the other of the open status or the closed status comprises changing the registration status based at least in part on the determined second credit risk. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine a credit risk that includes a first credit risk and determine subsequent to setting the registration status to a second credit risk associated with making payments on behalf of the network user; and changing the open status to the closed status based at least in part on the determined second credit risk because this would result in the increase in security of the

payment system by minimizing the opportunity for alteration of the negotiable instruments and according to the credit risk being low the status should be set to the first payment status and if the credit risk is high the payment status should be set to the second payment status in order to reduce the credit risk of the payee.

Claims 61 and 71. Kitchen and "Yahoo! E-Bills" failed to disclose, wherein a payee is included in the defined plurality of preferred payees as a result of (i) an agreement between the payee and the processing agent (ii) an agreement between a sponsor associated with the network user and the processing agent or (ii) an analysis of a history of payments directed to the payee. Britto discloses, wherein a payee is included in the defined plurality of preferred payees as a result of (i) an agreement between the payee and the processing agent (ii) an agreement between a sponsor associated with the network user and the processing agent or (ii) an analysis of a history of payments directed to the payee (col. 6, lines 13-33).

Claims 62 and 72. Kitchen, "Yahoo! E-Bills", and Britto failed to disclose, further comprising: changing the registration status from the closed status to the open status. Embrey discloses, further comprising: changing the registration status from the closed status to the open status (col. 15, lines 4-17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kitchen with the teachings of Embrey because such a modification would allow Kitchen to change the payment status according to the increased risk of the user and to achieve efficient operation and streamline the costs for accounting and disbursement activities.

Claims 63 and 73. Kitchen and "Yahoo! E-Bills" failed to disclose, further comprising:

notifying the network user of the change in registration status. Britto discloses, notifying the network user of the change in registration status (col. 7, line 39-col. 8, line 25).

Claims 64 and 74. Kitchen, "Yahoo! E-Bills", Britto and Embrey failed to disclose, wherein the registration status is initially set to the closed status, and further comprising: receiving a request from the network user to upgrade from the closed status to the open status, wherein the registration status is changed from the closed status to the open status responsive to the received request. It would have been obvious to one having ordinary skill in the art at the time the invention was made to receive a request from the network user to upgrade from the closed status to the open status, wherein the payer status is changed from the closed status to the open status responsive to the received request because this would allow for a more cost efficient and economical operating procedure.

Claims 65 and 75. Kitchen failed to disclose, further comprising: storing payment history associated with the network user, wherein the registration status is changed based on the stored payment history. Britto discloses, further comprising: storing payment history associated with the network user, wherein the registration status is changed based on the stored payment history (col. 6, lines 13-33).

Claims 66 and 76. Kitchen, Britto and Embrey failed to disclose, wherein changing the registration status based on the stored payment history includes at least one of (i) determining a length of time the network user has been registered for payment processing, (ii) determining a number of payments directed by the network user, (iii) determining a number of payments directed by the network user for which a debit was

not honored, or (iv) determining a function relating a number of payments directed by the network user for which a debit was not honored to a total number of payments directed by the network user. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine a length of time the network user has been registered for payment processing, (ii) determine a number of payments directed by the network user, (iii) determine a number of payments directed by the network user for which a debit was not honored, or (iv) determining a function relating a number of payments directed by the network user for which a debit was not honored to a total number of payments directed by the network user because these steps would allow service provider to make payments on behalf of the payor to the payee in a manner which greatly reduces the operating and administrative costs for accounting and disbursement activities. Applicant(s) are reminded that as a matter of linguistic precision, optional or conditional elements (e.g. "or," "if", "may," etc.) do not narrow the claims because they can always be omitted. See also MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"Chase Gets Positive" by Bank Technology News;

"Keeping Banks In the Home EFT Driver's Seat" by Bank Network News;

"Wells-eBay Partnership Tackles Online Checks. (Brief Article) by Toonkel, By Jessica;

"How to put PC to work paying bills. (on-line electronic bill-paying via microcomputer) (Computer File) (column)" by Magid, Lawrence J.; and

"Makeover men" by Clow, Robert.

### ***Response to Arguments***

Applicant's arguments filed 07/28/09 have been fully considered but they are not persuasive.

1. Issue no. 1: Applicants' argue: It is respectfully asserted that neither Kitchen, Embrey, nor Britto either taken alone or in any combination thereof, teaches or suggest each and every element of the amended independent claims and Kitchen which is co-owned by the Assignee of the present application fails to teach or suggest at least the setting of a registration status for the network user to one of a closed status and an open status or the transmission of a closed payment screen when the registration status is set to the closed registration status and the transmission of an open payment screen when the registration status is set to the open registration status has been considered but is not persuasive. Response: Applicants' appear to be arguing the amendments to the claims. Kitchen was not expressly used to reject these claim limitations. Embrey in fig.'s 5-7 shows open screens and a report in Fig.'s 9-13, 15, 21, 23A-23C, 26-29, and 34 shows what is interpreted as closed payment screens. Further, claim 1 contains and "or" which makes optional which part of the claim limitation is used in the reference to reject the claim limitation. Claims 24, 38, 56, 60-62, 66, 70-72, 75, and 76 have a

similar issue. Applicant(s) are reminded that as a matter of linguistic precision, optional or conditional elements (e.g. "if," "or," "may," etc.) do not narrow the claims because they can always be omitted. See also MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Issue no. 2: Applicants' argue: The cited text of Embrey does not appear to relate to setting a registration status for the network user and Embrey fails to teach or suggest the transmission of a closed payment screen when the registration status is set to the closed registration status and the transmission of an open payment screen ... has been considered but is not persuasive. Response: See above the response to Issue no. 1. There is not any need to readdress this argument again.

Issue no. 3: Applicants' argue: Britto fails to suggest the setting of a registration status for the network user to one of an open or closed status based in part on a closed payment screen when the registration status and the transmission of an open payment screen when the registration status is set to the open registration status has been considered but is not persuasive. Response: Britto was not used to reject the claim limitation setting of a registration status for the network user to one of an open or closed status based in part on a closed payment screen when the registration status and the transmission of an open payment screen when the registration status is set to the open registration status.

It is noted that Applicants' were silent regarding the Examiner's taking of Official Notice. MPEP 2144.02 states "If Applicant does not traverse the Examiner's assertion

of official notice or Applicant's traverse is not adequate, the Examiner should clearly indicate in the next Office Action that the common knowledge or well-known in the art statement is taken to be admitted prior art because Applicant either failed to traverse the Examiner's assertion of Official Notice or that the traverse was inadequate. If the traverse was inadequate, the Examiner should include an explanation as to why it was inadequate."

"Claims in a pending application should be given their broadest possible interpretation". *In re Pearson*, 181 USPQ 641 (CCPA 1974).

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

During patent examination, the pending claims must be given the **broadest reasonable interpretation consistent with the specification**. Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is quite different from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. *In re Prater*, 162 USPQ 541 (CCPA 1969)

"We are not persuaded by any sound reason why, at any time before the patent is granted, an applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim ... However, this court has consistently taken the tack that claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification during the

examination of a patent application since the applicant may then amend his claims, the thought being to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified." *In re Prater*, 162 USPQ 541 (CCPA 1969).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### **Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Flexible Schedule.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Trammell James can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

November 8, 2009